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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,018	09/01/2001	Craig M. Janik	005532.P007	1644

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Archana B. Vittal  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

EXAMINER

GRIER, LAURA A

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/945,018

**Applicant(s)**

JANIK, CRAIG M.

**Examiner**

Laura A Grier

**Art Unit**

2644

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,5,6,11-14 and 61-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5,6,11-14,61 and 67 is/are rejected.
- 7) ☒ Claim(s) 62-66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of claims 61-67 and 2, 4-7, and 11-14 is withdrawn in view of the newly discovered reference(s) to application no. 10976458. Rejections based on the newly cited reference(s) follow.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 61 and 67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 or 7 of copending Application No. 10976458. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions related to converting and downloading audio data.

Regarding claim 61, claim 1 or claim 7 of Application No. 10976458 recites a local area network port to receive portions of a digital media file stored on a local server, and a volatile

memory, which reads on receiving a portion, therein; a microprocessor for converting a portion of the digital media file, which reads on converting, therein; and firmware for controlling the transfer of the portions of the digital media file into the memory such that is no interruption in media playback, which reads on receiving a subsequent portion of media file, wherein converting and receiving the portion of the digital media occurs simultaneously.

Regarding claim 67, claim 1 or claim 7 of Application No. 10976458 recites a local area network port to receive portions of a digital media file stored on a local server, and a volatile memory, which reads on receiving a portion, therein; a microprocessor for converting a portion of the digital media file, which reads on converting, therein; and firmware for controlling the transfer of the portions of the digital media file into the memory such that is no interruption in media playback, which reads on receiving a subsequent portion of media file, wherein converting and receiving the portion of the digital media occurs simultaneously.

4. Claims 2, 4, and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 or 7 of copending Application No. 10976458 in view of Janky.

Regarding claim 2 and 4, Application No. 10976458 discloses everything claimed as applied above (see claim 61). Application No. 10976458 discloses in claim 2 manipulating the transfer of the both the digital media file and the converted portion to the digital media file. However, However, Application No. 10976458 fails to disclose converting the digital media file into analog electrical data. Janky discloses a D/A converter for converting the digital data into

analog electrical data which is transferred to an digital audio playback device (col. 2, lines 1-32 and 42-63 and col. 4, lines 48-51 and col. 9, lines 1-46).

It would have been obvious to one of the ordinary skill at the time the invention was made to modify the invention of Application No. 10976458 by implementing a D/A converter for converting digital information or data into analog data as taught by Janky.

Regarding claim 5, Application No. 10976458 and Janky discloses everything claimed as applied above (see claim 2). Application No. 10976458 further discloses in claim 3 a portable electronic device, which reads on the claimed portable electronic device, therein.

5. Claims 11 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 or 7 of copending Application No. 10976458 in view of Janky.

Regarding claim 11, Application No. 10976458 discloses everything claimed as applied above (see claim 61). However, Application No. 10976458 fails to disclose a wireless transceiver via a wireless transfer protocol. Janky disclose wireless transfer of the audio data, thus a wireless transceiver via wireless transfer protocol in is taught, and as well as the portable digital audio playback device teaches the audio converter with a wireless LAN network as evident by the fact that a Wireless LAN modem may be used (col. 4, lines 48-63 and col. 2, lines 1-8).

It would have been obvious to one of the ordinary skill at the time the invention was made to modify the invention of Application No. 10976458 by implementing a wireless

transceiver via a wireless transfer protocol for the purpose of ensuring adequate and efficient transmission of the audio data.

Regarding claim 13, Application No. 10976458 and Janky discloses everything claimed as applied above (see claim 11). Janky discloses the portable device including connections with a Wireless Network, which obvious indicates network adapter.

6. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 or 7 of copending Application No. 10976458 in view of Janky in view of Anderson, U. S. Patent No. 6427165.

Regarding claim 12, Application No. 10976458 and Janky discloses everything claimed as applied above (see claim 61). However, Application No. 10976458 and Janky fails to disclose the wireless transfer protocol as IEEE 802.11.b. IEEE standards are well known and commonly used in the art. Anderson discloses the use IEEE 802.11 standards for use wireless networks (col. 4, lines 1-10). It would have been obvious to one of the ordinary skill in the art the time the invention was made to modify the invention of Application No. 10976458 and Janky by implementing a specific IEEE 802.11.b transmission standard for sufficient wireless digital data transmission.

7. Claims 6 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim claim 1 or 7 of copending Application No. 10976458 and Janky, and further in view of Adair.

Regarding claims 6 and 14, respectively, Application No. 10976458 and Janky discloses everything claimed as applied above (see claim 5 and 11, respectively). However, Application No. 10976458 and Janky specifically disclose the portable electronic device as a personal digital assistant (PDA). The examiner maintains that a PDA was well known in the art.

Regarding the PDA, in a similar field of endeavor, Adair discloses hand-held computers incorporating reduced area imaging devices. Adair discloses the use of a PDA for receiving transmitted or transferred audio data/signal from a PC (computer), figures 4 and 5 and col. 6, lines 38-42 and 19, lines 10-12).

Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Application no. 10976458 and Janky by providing a PDA, a small portable electronic device, for receiving or download audio.

This is a provisional obviousness-type double patenting rejection.

8. Claims 62-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 61-67 and claims 2, 4-6, 11-14 have been considered but are moot in view of the new ground(s) of rejection.

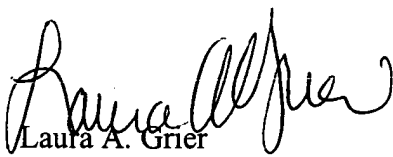
The applicant essentially provided remarks in regards to the amended changes in respect to previously amended subject matter. In respect to further search and consideration a Doubling Patent Rejection has been set forth as indicated in Non-final Rejection above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A Grier whose telephone number is (571) 272-7518. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh N Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura A. Grier  
April 4, 2005